

## **REMARKS/ARGUMENTS**

Claims 1-31 are pending in the present application. Claim 5 is canceled. Claims 1 and 31 are amended. Support for the amendment to claim 1 can be found in canceled claim 5. Support for the amendment to claim 31 can be found in the specification on page 14, line 19-20. No new matter has been added by any of the amendments. Reconsideration and allowance of the claims is respectfully requested.

### **I. 35 U.S.C. § 101**

The Examiner rejects claim 31 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Applicants have amended claim 31 accordingly, thereby overcoming the rejection.

### **II. 35 U.S.C. § 103, Obviousness**

The Examiner rejects claims 1-31 under 35 U.S.C. § 103 as obvious over *Mault, Monitoring System*, U.S. Patent Application Publication 2001/0044588 (November 22, 2001) (hereinafter “*Mault*”) in view of *Matthew et al., Environmental Heat Stress Monitor*, U.S. Patent Application Publication 2002/0009119 (January 24, 2002) (hereinafter “*Matthew*”). This rejection is respectfully traversed.

With respect to claim 1, the Examiner states that:

Mault discloses a system for collecting information about a user of an electronic consumable, comprising: an electronic consumable displayed using an apparatus, the apparatus having an input device and a sensor (paragraphs 2, 14 and 42, Mault); wherein the sensor is activated by a user action to collect information about the user's behavior as the user consumes the electronic consumable (paragraphs 7 and 15, Mault).

However Mault does not disclose the sensor being activated by a user action explicitly as disclosed.

Matthew teaches the user action activation of the sensor (paragraph 46, Matthew).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because they both are used to monitor and process data using sensors. Furthermore, the user activation being used to activate the sensor would make the sensor usage more effective (paragraphs 35, 39 and 45-46, Matthew).

Office Action dated June 1, 2007, pages 3-4.

*A prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32

F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the claimed invention have been properly considered and the teachings of the references themselves do not teach or suggest the claimed subject matter to a person of ordinary skill in the art.

Amended claim 1 is as follows:

1. A system for collecting information about a user of an electronic consumable, comprising:
  - an electronic consumable displayed on an apparatus, the apparatus having an input device and a sensor;
  - wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.

No *prima facie* obviousness rejection can be stated against claim 1 because neither *Mault* nor *Matthew* teach or suggest all features of amended claim 1. Applicants first address the teachings of *Mault*. *Mault* does not teach or suggest the features of “an electronic consumable” and “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.” The Examiner refers to the following portions of *Mault* as being relevant to claim 1:

[0002] This application relates to the monitoring of the physiological condition of a living subject, in particular, to the remote monitoring of the temperature of a subject using a sensor system which communicates with a computing device.

[0007] In preferred embodiments, this invention relates to a system for monitoring and recording body temperature employing a body mounted temperature sensor and transmitter which sends signals to a receiver connected to a personal digital assistant (PDA) which receives, records, processes and displays instantaneous temperature and a graph of temperatures over a time period and may transmit the temperature information to a remote location through a wired or wireless connection to the phone system, the Internet or the like. A PDA such as the Palm series (3Com Corp., Santa Clara, Calif.), Handspring Visor (Handspring, Inc., Mountain View, Calif.) or PocketPC types (such as the Compaq iPAQ) can be used.

[0014] In a preferred embodiment, the system comprises a sensor (preferably a temperature sensor), a computing device, (preferably a personal digital assistant or other portable computer, even more preferably a Palm PDA), a communications network (preferably the Internet), the computing device being connected to the network using a wireless connection. A server system (preferably a web server), a physician's computer (a computer accessible by the patient's physician), and a remote computing device (such as a PDA carried by another person with an interest in the patient, such as a relative) are connected to the network. The sensor system may average data, compensate for errors, or otherwise process data before

transmission to the computing device. The sensor also preferably comprises an electrical power supply, such as a battery. A photocell, electromagnetic wave receiver circuit, thermocouple, or the like may also be used to power the sensor. The computing device is adapted to receive data from the sensor, preferably using a Bluetooth protocol wireless transmitter/receiver (transceiver). The transceiver is preferably an integral part of computing device, such as part of a suitably adapted PDA, but an accessory can also be used.

[0015] In a preferred embodiment, a patient has a temperature sensor placed on or in its body. In a preferred embodiment, a skin mounted temperature sensor is used. A device which can be advantageously used in embodiments of the present invention is described in U.S. Pat. No. 5,844,862 (incorporated herein by reference). Temperature sensors such as the STD13 patient skin probe and STD14 disposable skin temperature probe, manufactured by Sensor Scientific, of Fairfield, N.J., can also be advantageously used in embodiments of the present invention. Skin temperature is usually lower than core body temperature, but trends in skin temperature are correlated with those of core temperature, and these trends are diagnostic of medical conditions of the patient. A core body temperature sensor, for example a thermometer inserted into an orifice (such as the mouth, ear, or other body opening) can also be used, and can also be used to determine the correlation between skin temperature and core temperature, allowing skin mounted sensors to be used with improved accuracy. Ear temperature sensors can also be advantageously used in embodiments of the present invention, such as described in U.S. Pat. No. 5,381,796 (incorporated herein by reference). Temperature sensors can also be incorporated into the patient's clothing, such as a diaper in the case of a baby, inserted into a skin fold or crevice, or otherwise disposed in or around the patient's body. A sensor system may be clipped to a waistband, wristband, other band or strap around a body part, for example by a clip or other attachment on a housing. A sensor system may be affixed to the skin of the patient, for example using an adhesive pad. An optical sensor can be used to monitor color changes in a colorimetric temperature sensor, such as one using cholesteric liquid crystals.

[0042] The computing device 20 is adapted to send a data stream over the communication network 30, which is preferably the Internet. The computing device can be (but is not limited to) a personal digital assistant (PDA) such as a Palm Pilot, portable computer, desk-top computer, wireless phone, interactive television component (e.g. set-top box, cable box, web-TV box, satellite box, etc.), electronic organizer, e-book, or a multi-functional device. In some embodiments, a PCMCIA (Personal Computer Memory Card International Association) card acts as an interface between the sensor 10 and the computing device 20. Schematics of PCMCIA interfaces, which can be advantageously used in embodiments of the present invention, are described in U.S. Pat. Nos. 6,159,147 and 5,827,179 to Lichter et al., herein incorporated by reference. The computing device may contain a transceiver card, so that wireless transmissions from one or sensor system can be detected. The sensor 10 and the computing device 20 can be an integrated device. For example, a PDA with a temperature monitoring accessory can be used.

The above portion of *Mault* discloses a system for the remote monitoring of the temperature of a subject using a sensor system which communicates with a computing device (paragraph 0002). A body mounted temperature sensor transmits signals to a receiver connected to a personal digital assistant (PDA)

and wherein the PDA records, processes, and displays instantaneous temperature and a graph of temperatures over a time period (paragraph 0007). Paragraph 0015 discloses different types of temperature sensors and different methods for affixing the sensors to the subject. Paragraph 0042 states that the computing device is adapted to send a data stream over a communication network. Paragraph 0042 further recites different embodiments of the computing device, such as a Palm Pilot, portable computer, desktop computer, etc.

However, *Mault* does not teach or suggest the features of “an electronic consumable” and “wherein the sensor is activated by a user action **by manipulating an object of the electronic consumable** to collect information about the user’s **behavior** as the user **consumes the electronic consumable** and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.” In regards to *Mault*, Applicants are unsure as to what the Examiner considers as an “electronic consumable”. The specification states the following in regards to an electronic consumable:

Electronic consumables, as that term is used in the present invention, includes subject matter that is transferable and displayable using electronic means, such as an eBook or other element of an eLibrary.

Specification, page 3, lines 5-9.

The only information disclosed by *Mault* that is being transferred and displayed is a user's physiological condition, such as a user's temperature. Thus, even if the Examiner considers a user's temperature to be an electronic consumable, which it is not, *Mault* does not teach “wherein the sensor is activated by a user action **by manipulating an object of the electronic consumable** to collect information about the user’s **behavior**.” In regards to a user’s behavior, the specification recites the following portion:

In such an example, the innovative system records various information about the user’s interaction with this page of the eBook. For example, the amount of time the user spends reading this page, whether hyperlink 304 was clicked, whether image 306 was clicked, and whether the reader stopped reading at this page can be recorded. Actions the user takes with respect to the content can trigger recording of these events, by virtue of embedded code that is part of the eBook and its individual objects. Likewise, the user's behavior can be recorded continually, noting behavior such as duration spent viewing particular windows or pages of the eBook.

Specification, page 9, line 23 through page 10, line 2.

*Mault* teaches monitoring a user’s physiological condition, which refers to the normal functions of the body, such as body temperature. Behavior refers to the user’s **interaction** with the electronic consumable. Behavior is not a physiological condition. Therefore, *Mault* does not teach “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s **behavior**.”

Additionally, *Mault* does not teach “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s behavior as the user **consumes the electronic consumable** and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.” Again, even if the Examiner considers a user’s physiological condition to be an electronic consumable, *Mault*’s disclosed user is not consuming anything. *Mault*’s disclosed user is simply having his temperature monitored. Thus, *Mault* also fails to teach this limitation of amended claim 1.

Furthermore, *Mault* does not teach the newly amended features of claim 1. For example, *Mault* does not teach “wherein the sensor is activated by a user action **by manipulating an object of the electronic consumable** to collect information about the user’s behavior as the user consumes the electronic consumable and **wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.**” The Examiner does not assert otherwise in addressing similar limitations previously recited in canceled claim 5. Consequently, because *Mault* fails to teach several limitations of amended claim 1, *Mault* does teach or suggest all the features of amended claim 1.

Additionally, *Matthew* does not teach or suggest the above-recited features of amended claim 1. *Matthew*, similar to *Mault*, teaches monitoring conditions under which physiological activity is occurring. The conditions monitored may be environmental, such as ambient temperature and humidity, or physiological, such as heart rate or body temperature (*See, Abstract*). Therefore, *Matthew* also does not teach “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s **behavior.**” Similarly, *Matthew* also does not teach the user **consuming an electronic consumable.**

Furthermore, *Matthew* also does not teach the newly amended features of claim 1. The Examiner erroneously asserts that *Matthew* teaches “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable” in rejecting similar limitations previously recited in canceled claim 5. The Examiner cites to the following portion of *Matthew*:

[0046] In operation, the user preferably deploys sensors 33-37 and activates monitor 10. Monitor 10 may be activated automatically when sensors are deployed or may be manually activated by the user. Upon activation, display 57 preferably shows various parameters and indicia including date, time and power status. The user may then activate a selection menu on LCD 57 and select the appropriate input parameters, i.e., the type of clothing, the work rate and the acclimation status. The input parameters are then transferred to CPU 110. The selection menu preferably provides the user with a variety of options for each parameter from which the user may select. Further, upon activation of the monitor 10, sensors 33-37 collect data and transmit the collected to CPU 110. The user may then request computation of any one or more of the safety factors and environmental parameters described above. In accordance with a preferred aspect of the invention, over a two-minute span, sensor measurements may be made at one-second intervals,

averaged and input to CPU 110. The safety factors may be calculated and output by CPU 110 either to display 57 or to a remote server in as little as three seconds. A preferred algorithm for calculation of safety factors and environmental parameters is depicted in FIG. 2. Accordingly, environmental monitor 10 provides real time computation of safety factors.

*Matthew*, paragraph 0046.

The above paragraph of *Matthew* states that “the user preferably deploys sensors 33-37” but *Matthew* fails to specify how the user “deploys” the sensors. Specifically, *Matthew* does not teach an “electronic consumable” and further fails to teach where **manipulating an object** of the electronic consumable activates the sensor, as recited in the amended features of claim 1. Applicants respectfully request that the Examiner specifically point out where these features are taught by *Matthew* if the rejection is maintained. Therefore, because *Matthew* fails to teach several limitations of the feature “wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user’s behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object,” as recited in amended claim 1, *Matthew* also does teach or suggest all the features of amended claim 1.

Accordingly, because neither *Mault* nor *Matthew* teach or suggest all of the features of amended claim 1, the proposed combination of *Mault* and *Matthew* when considered as a whole does not teach or suggest all of the features of claim 1. Therefore, the Examiner fails to state a *prima facie* obviousness rejection of claim 1.

Furthermore, because the remaining claims were rejected under the same rationale as claim 1, the same distinctions between the cited references vis-à-vis claim 1 applies to the remaining claims. Thus, under the standards of *In re Royka*, the Examiner fails to state a *prima facie* obviousness rejection of claims 1-31. Therefore, the rejection of claims 1-31 under 35 U.S.C. § 103 has been overcome.

### **III. 35 U.S.C. § 102, Anticipation**

The Examiner rejects claims 1-8, 19-22, 24-28, and 30 under 35 U.S.C. § 102 as anticipated by *Hoshi et al.*, System for Acquiring and Analyzing Personal Profile Data and Providing the Service of Delivering Various Information, U.S. Patent Application Publication 2002/0083043 (Jun. 27, 2002) (hereinafter “*Hoshi*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32

U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Regarding claim 1, the Examiner states that:

*Hoshi* discloses a system for collecting information about a user of an electronic consumable, comprising: an electronic consumable displayed using an apparatus, the apparatus having an input device and a sensor; wherein the sensor is activated by a user action to collect information about the user's behavior as the user consumes the electronic consumable (page 3 paragraph 0058 and 0059, *Hoshi*).

Office Action of February 16, 2006, p. 3.

Amended claim 1 is reproduced below:

1. A system for collecting information about a user of an electronic consumable, comprising:
  - an electronic consumable displayed using on an apparatus, the apparatus having an input device and a sensor;
  - wherein the sensor is activated by a user action by manipulating an object of the electronic consumable to collect information about the user's behavior as the user consumes the electronic consumable and wherein embedded code of the object causes the information to be recorded in response to the user manipulating the object.

*Hoshi* does not anticipate claim 1 because *Hoshi* does not teach several limitations of the recited features of amended claim 1. The Examiner asserts otherwise, citing from *Hoshi*. The paragraphs cited by the Examiner are as follows:

[0058] In yet another aspect of the present invention, at least either a sensor system or an actuator system is connected to each node, and control is carried out so that at least either the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation.

[0059] Accordingly, the user can monitor the results of sensor-based measurement or detection on the screen and operate with the actuator system of interest from the screen.

*Hoshi*, paragraphs 0058 and 0059.

In the above cited paragraphs *Hoshi* teaches a sensor system or an actuator system is connected to each node. A control is carried out so that at least the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation. *Hoshi* then states that these functions allow the user to monitor the results of sensor-based measurement or detection and then operate the actuator accordingly.

However, the above-cited text does not teach all the limitations of the feature “an electronic consumable displayed **on** an apparatus, **the apparatus** having an input device and a sensor” as recited in amended claim 1. The above portion of *Hoshi* teaches a sensor system, however, *Hoshi* clearly depicts that the sensor (sensor 14 in Figure 3) is part of node 11. Thus, in order for *Hoshi* to anticipate the limitation of the above recited feature of amended claim 1, *Hoshi* must display an electronic consumable **on** node 11. However, even if, *arguendo*, *Hoshi* teaches an electronic consumable, *Hoshi* teaches displaying content on TV 5 and not on node 11 (*See*, paragraph 0156, “output from the node 11 to the TV 5 for display”). Thus, *Hoshi* does not teach the above recited feature of claim 1.

Furthermore, *Hoshi* does not teach the amended feature “wherein the sensor is activated by a user action by manipulating **an object of the electronic consumable** to collect information about the user’s behavior as the user consumes the electronic consumable and wherein **embedded code of the object causes the information to be recorded** in response to the user manipulating the object” as recited in claim 1. The Examiner asserts otherwise in rejecting similar limitations previously recited in canceled claim 5 (Office Action dated June 1, 2007, page 20). The paragraphs cited by the Examiner are as follows:

[0146] In addition to the cache memory, the node 11 may be provided with another memory 13 for regularly storing user-specific data items, as necessary, including the profile data of the user 2 and advertisement and information content based on the profile data, so that the node 11 autonomously and selectively reads out necessary content in response to remote controller operation by the user 2 and shows them on the TV screen.

[0147] Furthermore, a plurality of sensors 14 for on-demand remote monitoring by the user 2, such as thermometers and cameras, and a plurality of actuators 15 for remote operation by the user 2, such as switches and control mechanisms, are connected to the node 11 as necessary.

*Hoshi*, paragraphs 0146 and 0147.

In paragraph 0146 *Hoshi* teaches that node 11 is provided with memory for storing user-specific data. User specific data includes the profile data of the user, as well as advertisement and information content based on the profile data. The node autonomously and selectively reads out content in response to remote controller operation by the user. *Hoshi* teaches in paragraph 0147 that sensors for on-demand remote monitoring are connected to the node as necessary. *Hoshi* describes the use of these sensors elsewhere.

However, these paragraphs do not teach “wherein the sensor is activated by a user action by manipulating **an object of the electronic consumable** to collect information about the user’s behavior as the user consumes the electronic consumable and wherein **embedded code of the object causes the information to be recorded** in response to the user manipulating the object” as recited in claim 1. *Hoshi* is devoid of any teachings in regards to manipulating **an object of the electronic consumable** to collect



information. Applicants assume the Examiner is referring to advertisements and information content stored within node 11 as electronic consumables, however, *Hoshi* does not teach that objects of the advertisements or information content are being manipulated to collect information. The above portion of *Hoshi* simply teaches the storing and retrieving of information, such as advertisements, and is devoid of any teachings in regards to manipulating an object of the advertisements or information content to collect information.

Additionally, *Hoshi* does not teach collecting information about the user's **behavior** as the user consumes the electronic consumable. The Examiner admittedly states "*Hoshi* does not explicitly disclose monitoring and reporting user behavior as claimed" with respect to her rejection of claim 9 (Office Action dated June 1, 2007, page 24). Thus, it would be contradictory for the Examiner to assert that *Hoshi* teaches collecting information about the user's behavior as the user consumes the electronic consumable, i.e., monitoring the user's behavior, if this information is never reported as admitted by the Examiner. Thus, *Hoshi* also fails to teach this limitation of the recited feature of amended claim 1.

Furthermore, *Hoshi* fails to teach "wherein **embedded code of the object causes the information to be recorded** in response to the user manipulating the object" as recited in claim 1. *Hoshi* teaches that memory associated with the node can contain user-specific data that the node uses to read out content in response to user input. This concept has nothing to do with **embedded code in an object of the electronic consumable** causing information to be recorded, as recited in amended claim 1. In other words, *Hoshi* teaches that content is selected according to user profile data, but *Hoshi* does not teach that information is recorded using embedded code in an object of the content. Accordingly, *Hoshi* does not anticipate amended claim 1.

Because claims 2-8 depend from amended claim 1, the same distinctions between *Hoshi* and amended claim 1 can be made for these claims. Additionally, claims 2-8 claim other additional combinations of features not suggested by the reference. For example, *Hoshi* does not teach that the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function, as recited in claim 6. The Examiner's assertions to the contrary are manifestly incorrect based on the plain text of *Hoshi*. Consequently, the rejection of claims 1-8 have been overcome.

Additionally, *Hoshi* does not anticipate claims 19-22, 24-28, and 30 for the reasons presented above. Furthermore, *Hoshi* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Hoshi* and the features of the claimed inventions, one of ordinary skill in the art would not be led to modify *Hoshi* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Hoshi* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

### III.A. *Rebuttal to the Examiner's Response*

In response to these facts the Examiner asserts the following:

*Third, Applicant argues that there is no teaching in Hoshi that and that the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function and the information is collected according to embedded code in an object of the electronic consumable.*

*In response to Applicant's argument, the Examiner submits that Hoshi discloses the TV program guide that stores items of broadcast and content delivery section, is obtained by the node 11 that is connected to the set top box. The set top box is inherently a hardware that would be programmed with some code to perform its functionalities of gathering information, storing it and then transmitting it for processing and analysis as explained in paragraph 0140. The information is collected according to what is being views keeping in mind the profile of the user and this would be possible to implement on a piece of hardware only it contained code embedded in it. Also the TV program guide is content information embedded in some language or code.*

Office Action dated June 1, 2007, page 16.

The Examiner asserts that *Hoshi* discloses the TV program guide that stores items of broadcast and content is obtained by the node 11 that is connected to the set top box. The Examiner believes that the set top box is inherently a hardware that would be programmed with some code to perform its functionalities of gathering information, storing information, and then transmitting the information for processing and analysis. The Examiner also asserts that the implementation of *Hoshi's* system could be implemented on a piece of hardware containing embedded code.

However, the Examiner misunderstands the limitations of amended claim 1. Amended claim 1 requires that, “wherein **embedded code of the object causes the information to be recorded** in response to the user manipulating the object.” The Examiner’s comments are directed towards embedded code in hardware, particularly in the set top box, and not embedded code in an object of an **electronic consumable**. A set top box is not an electronic consumable. Therefore, the Examiner’s reference to a set top box having embedded code is irrelevant to the limitations of the recited feature of amended claim 1.

Furthermore, the Examiner states that “the TV program guide is content information embedded in some language or code.” However, claim 1 is directed to embedded code of an object that **causes information to be recorded** in response to the user manipulating the object. Applicants agree that the TV program guide is written in some code language, however, *Hoshi* does not teach that manipulating an object of the TV program guide that would cause information to be recorded, as recited in amended claim 1. Thus, the Examiner’s rebuttal to the above arguments does not show that *Hoshi* teaches all of the limitations of the recited features of amended claim 1.

#### IV. 35 U.S.C. § 103, Obviousness

The Examiner rejected claims 9-18, 23, 29, and 31 under 35 U.S.C. § 103 as obvious over *Hoshi* in view of *Fedorovskaya et al.*, Imaging Method and System, U.S. Patent Application Publication 2004/0101212 (May 27, 2004) (hereinafter “*Fedorovskaya*”). This rejection is respectfully traversed.

With respect to claim 9, the Examiner states that:

*Hoshi* disclose a system for collecting information about a user of an electronic consumable, comprising: an apparatus capable of displaying an electronic consumable; an electronic consumable comprising documents and objects; wherein the documents and objects include instructions for automatically monitoring and reporting user behavior; and wherein a user action triggers the monitoring and reporting of the user behavior (paragraphs 0058, 0059 and 0239, *Hoshi*).

*Hoshi* does not explicitly disclose monitoring and reporting user behavior as claimed.

*Fedorovskaya* teaches monitoring and reporting of user behavior (paragraph 0036 and 0047, *Fedorovskaya*).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of the cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, *Fedorovskaya*). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, *Fedorovskaya*).

Office Action dated June 1, 2007, pages 24-25.

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In this case, the Examiner has failed to state a *prima facie* obviousness rejection of claim 9 because the proposed combination does not teach all of the features of claim 9.

Claim 9 is as follows:

9. A system for collecting information about a user of an electronic consumable, comprising:
  - an apparatus capable of displaying an electronic consumable;
  - an electronic consumable comprising documents and objects;
  - wherein the documents and objects include instructions for automatically monitoring and reporting user behavior; and

wherein a user action triggers the monitoring and reporting of the user behavior.

The proposed combination does not teach all of the features of claim 9 because neither *Hoshi* nor *Fedorovskaya* teach or suggest “an electronic consumable comprising documents and objects; wherein the documents and objects include instructions for automatically monitoring and reporting user behavior”, as recited in claim 1. Nevertheless, the Examiner asserts that *Hoshi* does teach this claimed feature, citing from *Hoshi* as follows:

[0058] In yet another aspect of the present invention, at least either a sensor system or an actuator system is connected to each node, and control is carried out so that at least either the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation.

[0059] Accordingly, the user can monitor the results of sensor-based measurement or detection on the screen and operate with the actuator system of interest from the screen.

[0239] By installing a camera or cameras in the room, it is also possible to determine who among the family members is watching the TV.

*Hoshi*, paragraphs 0058, 0059, and 0239.

As described above, these paragraphs teach a sensor system or an actuator system is connected to each node. A control is carried out so that at least the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation. *Hoshi* then states that these functions allow the user to monitor the results of sensor-based measurement or detection and then operate the actuator accordingly.

However, nothing in the cited text teaches or suggests an electronic consumable comprising documents and objects; wherein the documents and objects include instructions for automatically monitoring and reporting user behavior. *Hoshi* is completely devoid of any teaching or suggestion of an electronic consumable comprising **documents** and objects. Thus, *Hoshi* does not teach the recited features of claim 9. Furthermore, the Examiner admits that *Hoshi* fails to teach monitoring and reporting user behavior as claimed. Thus, *Hoshi* also does not suggest the recited features of claim 9.

Additionally, *Fedorovskaya* does not teach this claimed feature, and the Examiner does not assert that *Fedorovskaya* teaches this claimed feature. Because neither reference teaches or suggests this claimed feature, the proposed combination does not teach or suggest all of the features of claim 9. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 9.

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against claim 9 because the Examiner failed to state an articulated reason why one of ordinary skill in the art would look to combine the teachings of the references. The Examiner bears the burden of establishing a *prima facie*

case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Regarding a reason to combine the references, the Examiner states that:

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of the cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, *Fedorovskaya*). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, *Fedorovskaya*).

Office Action dated June 1, 2007, page 25.

The Examiner asserts that it would have been obvious to combine the references because the analysis of captured behavior would lead to an accurate profiling of the users and that the classifications of emotions portrayed in pictures help in reviewing the information. However, the Examiner has only stated a purported advantage of combining the references. In the case at hand, the Examiner has failed to recognize the disadvantages of the combining of the references. For example, one of ordinary skill in the art would have a reason to avoid combining the references because large amounts of memory and processor power, hence a large expense, would be required to implement profiling a user's emotions and facial expressions. The Examiner provided no reason to overcome this disadvantage to avoid combining the references.

Furthermore, the Examiner provided no reason why the purported increased accuracy is necessary or even desirable. For example, *Hoshi's* method is complete in and of itself for the purpose *Hoshi* intends. *Hoshi's* method does not require "increased accuracy." Given the lack of a need for increased accuracy, and given the increased costs of implementing the technology described in *Fedorovskaya*, one of ordinary skill would have no reason to combine the references to achieve the invention of claim 9. Thus, the Examiner's purported advantage is merely a conclusory statement not supported by some rational underpinning to support the legal conclusion of obviousness.

For the reasons presented above, the Examiner has failed to provide an articulated reason as to why one of ordinary skill in the art would look to combine the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 9.

Consequently, because claims 9-18 depend from claim 9, the proposed combination of *Hoshi* and *Fedorovskaya*, when considered as a whole, does not teach or suggest all of the features of the dependent claims. Similarly, as previously shown, the proposed combination of *Hoshi* and *Fedorovskaya*, when considered as a whole, does not teach or suggest all of the features of claims 23, 29, and 31. Thus, under the standards of *In re Royka*, the Examiner fails to state a *prima facie* obviousness rejection of claims 9-18, 23, 29, and 31. Therefore, the rejection of claims 9-18, 23, 29, and 31 under 35 U.S.C. § 103 has been overcome.

**V. Conclusion**

The subject application is patentable over the cited references and should now be in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 31, 2007

Respectfully submitted,

/Theodore D. Fay III/

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